

Appl. No. 09/351,086
Amendment and/or Response
Reply to Office action of 21 March 2005

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REMARKS / DISCUSSION OF ISSUES

Claims 1-25 are pending in the application.

The Office action rejects claims 1-10 and 18-25 under 35 U.S.C. 102(e) over Hjelsvold et al. (USP 6,546,555, hereinafter Hjelsvold). The applicant respectfully traverses this rejection.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1, upon which claims 2-10 depend, claims a method that includes displaying information from an additional information source based on a selection by a user of a feature in a video segment while the video segment is displayed to the user.

Hjelsvold does not teach displaying information from an additional information source based on a selection by a user of a feature in a video segment while the video segment is displayed to the user.

Hjelsvold teaches a technique for creating customized video streams, depending upon a prior choice by the end-user. In Hjelsvold, a hypervideo includes a variety of "versions" of video streams, and a "filtering system" determines which stream is presented to the viewer, based on the current classification of the viewer. The viewer chooses which class to join (and thereby what price to pay), and the filters subsequently route the appropriate image frames to the viewer to form the appropriate video stream. As specifically taught by Hjelsvold:

"The service administration system includes ... a meta-data editing tool for the merchant to prepare the content for the filtering ... the system will pass the selected video through a sequence of service filters to generate the edition that the customer *selected*." (Hjelsvold Abstract, lines 9-17.)

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The Office action references FIGs. 16-18 as illustrating the applicant's claimed invention. The applicant notes that FIG. 16 merely illustrates a hypervideo that includes three possible versions of video streams, depending upon whether the user is a "standard customer", an "affiliate customer", or a "standard user".

FIG. 17 illustrates that the next frame to be presented to the viewer is information ("NSS") about the displayed product. As noted in the text, "the same NSS will be shown to the end-user in all three versions of the hypervideo" (Hjelsvold, column 12, lines 9-10). Therefore, only one next-frame is illustrated in FIG. 17.

FIG. 18 is an example where three different next frames are included in the hypervideo, and "the hypervideo is also branching depending on which version the customer is viewing" (Hjelsvold, column 12, lines 12-14). That is, if the user is a "premium customer", the user receives the uppermost next scene in FIG. 18; if the user is an "affiliate customer", the user receives the middle next scene; and if the user is a "standard customer", the user receives the lowermost next scene.

That is, in Hjelsvold, the user chooses a version of a video presentation, and the filtering system dynamically controls which image frames from a hypervideo are routed to the user, corresponding to the selected version:

"The filtering process will select only the hyperlink that is appropriate for the price category selected by the end-user and include it in the data stream. Thus, the user can but only access one of the defined information planes." (Hjelsvold, column 11, lines 62-66.)

Because Hjelsvold does not teach displaying information from an additional information source based on a selection by a user of a feature in a video segment while the video segment is displayed to the user, as specifically claimed in claim 1, the applicant respectfully maintains that claims 1-10 are patentable under 35 U.S.C. 102(e) over Hjelsvold.

In like manner, claims 18-20 and 24 also include displaying information from an additional information source based on a selection by a user of a feature in a video segment while the video segment is displayed to the user.

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Because Hjelsvold does not teach displaying information from an additional information source based on a selection by a user of a feature in a video segment while the video segment is displayed to the user, as specifically claimed in claims 18-20 and 24, the applicant respectfully maintains that claims 18-20 and 24 are patentable under 35 U.S.C. 102(e) over Hjelsvold.

Claims 22, 23, and 25 each claim the display of information from an additional information source when a first video segment is displayed.

Hjelsvold does not teach the display of information from an additional information source when a first video segment is displayed. Hjelsvold specifically teaches the creation of versions of a video presentation that is presented to the user as a continuous video stream. Hjelsvold's FIGs. 17 and 18 illustrate that Hjelsvold's hypervideo process determines each "next scene" (in FIG. 17) or each "next linked hyper video scene" (in FIG. 18); Hjelsvold is silent regarding simultaneously presenting information from a second source while the first video segment is displayed.

Because Hjelsvold does not teach the display of information from an additional information source when a first video segment is displayed, as specifically claimed in claims 22, 23, and 25, the applicant respectfully maintains that claims 22, 23, and 25 are patentable under 35 U.S.C. 102(e) over Hjelsvold.

The Office action rejects:

claims 11-16 under 35 U.S.C. 103(a) over Hjelsvold and Jain et al. (USP 6,463,444, hereinafter Jain); and
claim 17 under 35 U.S.C. 103(a) over Hjelsvold.

The applicant respectfully traverses these rejections.

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The Examiner's attention is requested to MPEP 2142, wherein it is stated:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

In each of these rejections, the Office action relies upon Hjelsvold for teaching the elements of claim 1, upon which each of these rejected claims depend. As noted above, Hjelsvold does not teach the elements of claim 1, and thus a *prima facie* case of obviousness has not been established.

Because Hjelsvold does not teach the elements relied upon in these rejections, the applicant respectfully maintains that these rejections under 35 U.S.C. 103(a) are unfounded.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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